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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,607	01/12/2004	Andrew W. Jamieson	040121	9938

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EXAMINER

HAAS, WENDY C

ART UNIT PAPER NUMBER

1661

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/755,607

Applicant(s)

JAMIESON, ANDREW W.

Examiner

Wendy C. Haas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Plant Breeder's Right Application Number 97-999, published April 30, 1997 (more than one year prior to the priority date of the instant application) in view of applicant's admission of July 8, 2003 (of record in Application Serial Number 10/073,447) that "Evangeline" was first commercialized in Canada in 1999." The Examiner refers applicant to In re Elsner, 381 F.3d 1125, 72 U.S.P.Q. 1038 (Fed. Cir. 2004), which holds that a published application, combined with foreign public possession of a claimed plant may constitute an anticipatory reference under 35 U.S.C. § 102(b).

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Plant Breeder's Right Grant Number 0617, published August 10, 1999 (more than one year prior to the priority date of the instant application) in view of applicant's admission of July 8, 2003 (of record in Application Serial Number 10/073,447) that "Evangeline" was first commercialized in Canada in 1999." The Examiner refers applicant to In re Elsner, 381 F.3d 1125, 72 U.S.P.Q. 1038 (Fed. Cir. 2004), which holds that a published application, combined with foreign public possession of a claimed plant may constitute an anticipatory reference under 35 U.S.C. § 102(b).

Conclusion

No claim is allowed.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

References Cited

The cited references were provided in response to the Examiner's Requirement for Information; however no Form 1449 was provided. The Examiner is citing the provided references to make them officially of record in the application.

Comments

Should applicant elect to appeal the rejection of record, the following information may prove useful:

Under Elsner, the Office must show the following facts and/or evidence in order to establish a *prima facie* case of unpatentability under 35 U.S.C. § 102(b) based on a publication disclosing the claimed plant made more than one year prior to the filing date of application for patent in the United States:

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1. A publication disclosing the claimed plant published more than one year prior to the effective filing date of the United States application for patent. Elsner, 381 F.3d at 1129;
2. Public possession of the claimed plant more than one year prior to the effective filing date of the United States application for patent. *Id.* at 1130. Public possession is defined as “availability known in the art” rather than “an obscure, solitary occurrence.” *Id.* at 1131;
3. Reproducibility of the claimed plant by a person of ordinary skill in the art without undue experimentation. *Id.*

The rejections of record meet the criteria set forth in Elsner in the following ways:

1. Canadian Plant Breeder’s Right Application Number 97-999 was published April 30, 1997 and Canadian Plant Breeder’s Right Grant Number 0617 was published August 10, 1999, both more than one year prior to the effective filing date of the instant application for patent. The breeder’s right grant lists the breeder’s name as “Agriculture & Agrifood Canada, Kentville”. The Examiner’s Internet search for “Agriculture & Agri-Food Canada” revealed as the first two search results the breeder’s web sites: <http://www.agr.gc.ca/> and http://www.agr.gc.ca/index_e.phtml.
2. Applicants’ admission in the Remarks filed July 14, 2003 in case serial number 10/073,447 (the parent case) stated that the claimed plant was first publicly available in Canada on May 3, 1999, more than one year prior to the effective

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filing date of the instant application for patent. Since Applicants are in the business of selling plants, it is assumed that this sale constitutes “availability known in the art” rather than “an obscure, solitary occurrence.” Applicants provided further information regarding sale(s) of the claimed plant during the critical time period in response to the Requirement for Information made with the last Office Action. The invoices of the C. O. Keddy Nursery, Inc. provide evidence that availability of the claimed plant more than one year prior to the effective filing date of the instant application for patent constitutes “availability known in the art”. *See, e.g.* sale of 5000 ‘Evangeline’ strawberry plants on 6/15/00 to Anthony VanOestrup, sale of 3000 ‘Evangeline’ strawberry plants on 4/18/00 to Glen Hebb, sale of 1000 ‘Evangeline’ strawberry plants on 5/11/00 to Lady Slippers Gardens.

3. Applicant’s Specification notes that the claimed plant was asexually reproduced “via stolons”, a common method known in the art.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

KENT BELL
PRIMARY EXAMINER

Kent L. Bell